

Remarks

This Application has been carefully reviewed in light of the Office Action mailed October 29, 2008. Applicant has amended dependent Claim 35 to correct a clerical error in the claim. This amendment is not considered narrowing or necessary for patentability. Applicant believes all claims are allowable without amendment and respectfully provides the following remarks. Applicant respectfully requests reconsideration and allowance of all pending claims.

The Claims Recite Patentable Subject Matter

The Examiner rejects Claims 1, 4, 6-9, 12-17, 20-22, 25-28, and 31-36 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant respectfully traverses these rejections.

Regarding independent Claims 9 and 28 and their dependent claims, the Examiner states that these claims recite a “directory services arrangement” and that such directory services “are non-functional descriptive material and an abstract idea.” *Office Action* at 2-3. The Examiner further states, “It is definitely not stored on an appropriate computer-readable medium. Therefore, claims 9 and 28 fail to fall within a statutory category.” *Office Action* at 3.

With respect to independent Claim 9, Applicant respectfully submits that the Examiner has not provided any authority supporting the notion that these claims “are non-functional descriptive material and an abstract idea,” or that the elements of these claims must be “stored on an appropriate computer-readable medium.” Independent Claim 9 is an apparatus claim with one or more claim elements written in compliance with 35 U.S.C. § 112, ¶ 6 (i.e., means-plus-function claim elements) and is plainly statutory.

With respect to Claim 28, the Examiner adds that “Claim 28 recites one or more memory modules. Such memory modules are programs. Therefore, claim 28 is a program per se. [I]t appears such modules are not stored on an appropriate computer-readable medium.” *Office Action* at 3.

Claim 28 is directed to a directory services arrangement that comprises “one or more memory modules” and “one or more processing units.” Thus, Claim 28 is directed to an apparatus that comprises one or more physical components. The Examiner’s indication that “[s]uch memory modules are programs” is confusing, as the Examiner does not provide any basis for this assertion. In any event, both one or more memory modules and one or more processing units are physical apparatus components. While a memory module may be encoded with or otherwise include a computer program, the memory module itself is not a computer program. Thus, Applicants respectfully submit that the premise for the Examiner’s rejection is incorrect, and that Claim 28 is drafted in a manner consistent with controlling Federal Circuit case law and the M.P.E.P.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 9 and 28 and their dependent claims.

With respect to Claims 1, 17, and 36, the Examiner argues that “there is no end result under the condition when the determination is made that the filter item comprises a NOT connective and a type filter item.” *Office Action* at 3. According to the Examiner, “Applicant should duly note that the Specification requests that both conditions be satisfied in order to process the database service query. Therefore, the claims fail to fall within a statutory category.” *Office Action* at 3.

First, Applicant and the Examiner have already addressed this very issue in prior Office Actions, and the claims were subsequently allowed. *See, e.g., Office Action* mailed 4/11/07 at 4; *Applicant’s Response* mailed 7/11/07 at 12-14; *Final Office Action* mailed 10/11/07 at 2-4; *Applicant’s Response to Final* mailed 12/11/07 at 8-10; *Applicant’s Pre-Appeal Brief Request for Review* mailed 3/11/08 at 3-4; and *Notice of Panel Decision* mailed 4/3/08. After the *Notice of Panel Decision*, this issue was not raised again by the Examiner. Applicant respectfully submits that revisiting previously-resolved issues plainly thwarts the goal of compact prosecution.

Second, Applicant does not necessarily agree with or acquiesce to the Examiner’s assertion that “the Specification requests that both conditions be satisfied in order to process

the database service query.” The simple fact that Applicant’s Specification may disclose an example embodiment in which certain operations or possible outcomes may be described or performed does not require Applicant’s claims to recite each and every operation or possible outcome. As Applicant stated the first time this rejection was presented, the Examiner essentially is requiring the claims to recite each possible outcome of the determinations made in Claim 1 (for example) for the claim to be statutory. The Examiner has provided no support for this requirement in the current Office Action. Therefore, Applicant submits that the claims are directed to patentable subject matter.

Furthermore, it is unclear to Applicant how any of the Examiner’s comments with respect to Claims 1, 17, and 36 lead to a conclusion that the claims “fail to fall within a statutory category.” *Office Action* at 3.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1 and its dependent claims. For at least certain analogous reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 17 and 36 and their dependent claims.

No Waiver

All of Applicant’s arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner’s additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner’s rejections.

Conclusion


Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad D. Terrell, Attorney for Applicant, at the Examiner's convenience at (214) 953-6813.

Although Applicant believes no fees are due, the Commissioner is hereby authorized to charge any necessary fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicant



Chad D. Terrell
Reg. No. 52,279

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CORRESPONDENCE ADDRESS:

Customer No. **05073**